

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Naoto NAKAMURA et al.



Attn: PCT Branch

Application No.: 10/528,069

Docket No.: 122733

Filed: March 15, 2005

For: THERMAL TREATMENT APPARATUS, METHOD FOR MANUFACTURING
SEMICONDUCTOR DEVICE, AND METHOD FOR MANUFACTURING
SUBSTRATE

**RESPONSE TO SUPPLEMENTAL DECISION ON APPLICANTS' PETITION
UNDER 37 C.F.R. §1.47(A) WITH EXECUTED DECLARATION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the March 13, 2006 Supplemental Decision on Petition (copy attached), and in consideration of the attached Petition for Two-Month Extension of Time, submitted herewith is the executed Declaration of the Inventors, and eleven replacement drawing sheets.

As is indicated in the Background section of the Supplemental Decision, Applicants filed an International Application PCT/JP03/12353 on September 26, 2003, which designated the United States and claimed a priority date of September 27, 2002. A copy of the International Application was communicated from the International Bureau to the U.S. Patent and Trademark Office on April 8, 2004. The 30-month period for paying the basic national fee in the United States expired on March 28, 2005.

Applicants filed a submission for entry into the national stage in the United States on March 15, 2005. This submission did not include an executed oath or declaration. A Notification of Missing Requirements under 35 U.S.C. §371 was mailed on August 26, 2005 indicating that an oath or declaration of the inventors, with an appropriate fee, was required.

In response to the Notice of Missing Requirements, Applicants filed a petition under 37 C.F.R. §1.47(a) which was accompanied by a Declaration of the Inventors and a Statement of Facts explaining why one of the inventors had not signed the Declaration. The Petition requested entry of the inventors' Declaration in favor of the four signing inventors and the one non-signing inventor.

A Decision on Petition was mailed dismissing Applicants' petition on March 3, 2006. Applicants' representative contacted the Patent Office and indicated that the March 3 Decision had apparently failed to take into account the Declaration of Facts accompanying Applicants' Petition. The attached Supplemental Decision on Petition was mailed on March 13, 2006. The Supplemental Decision dismissed Applicants' Petition without prejudice and set a 2-month extendible date from the mail date of the Decision for Applicants to further reply in order to avoid abandonment of the application.

In the interim, the non-signing inventor was located and agreed to sign a Declaration. Thus, the attached Declaration executed by all five inventors was obtained.

Additionally, Applicants submit formal drawings to replace the drawings originally filed with this application as indicated in the Supplemental Decision.

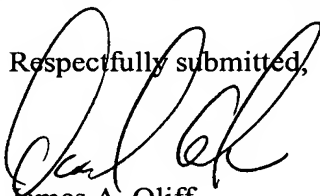
Applicants previously paid the fees due under 37 C.F.R. §1.492(h) and (i), and fees incumbent with consideration of Applicants' Petition. As such, Applicants believe that no further fees other than those associated with the attached Petition for Extension of Time are required regarding entry and consideration of the attached documents.

Entry of these documents should complete all of the filing formalities and fully satisfy all requirements of the previously-promulgated Notice of Missing Requirements, and fully respond to the Supplement Decision on Petition. Accordingly, prompt issuance of a Notification of

Acceptance and Official Filing Receipt, and prompt examination and allowance of this application on the merits are earnestly solicited.

The Commissioner is hereby authorized to charge any additional fee (or credit any overpayment) associated with this communication to Deposit Account No. 15-0461. Duplicate copies of this paper are attached.

Should any questions arise regarding this communication, all inquiries should be directed to Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Daniel A. Tanner, III
Registration No. 54,734

JAO:DAT/cfr

Attachment: Executed Declaration of the Inventors
Copy of March 13 Supplemental Decision on Petition
Replacement Drawing Sheets (Figs. 1-11)
Petition for 2-Month Extension of Time

Date: July 10, 2006

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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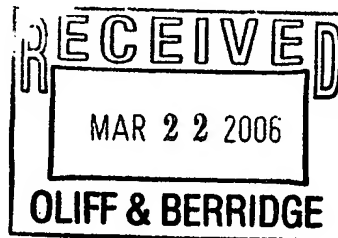
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In re Application of
NAKAMURA et al.
Application No.: 10/528,069
PCT No.: PCT/JP03/12353
Int. Filing Date: 26 September 2003
Priority Date: 27 September 2002
Attorney Docket No.: 122733
For: THERMAL TREATMENT APPARATUS,
METHOD FOR MANUFACTURING
SEMICONDUCTOR DEVICE, AND METHOD
FOR MANUFACTURING SUBSTRATE

SUPPLEMENTAL

DECISION

DUE DATE

MAY 13 2006

This decision is supplemental to the decision mailed 03 March 2006. That decision failed to take into account the declaration of facts by Mr. Akihiro Fukushima. Accordingly, the decision mailed 03 March 2006 is hereby VACATED.

BACKGROUND

On 26 September 2003, applicants filed international application PCT/JP03/12353, which designated the United States and claimed a priority date of 27 September 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 March 2005 (27 March 2005 being a Sunday).

On 15 March 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a translation of the application into English.

On 26 August 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 07 October 2005, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration of inventors, a declaration of facts by Mr. Akihiro

Fukushima, a copy of a letter sent to non-signing inventor Mr. Shimada on April 6, 2005 and an English translation thereof, a copy of a letter sent to Mr. Shimada on May 23, 2005 and an English translation thereof, and copies of two certified mail receipts and English translations thereof.

On 03 March 2006, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a). However, that decision failed to take into account the declaration of facts by Mr. Akihiro Fukushima.

DISCUSSION

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee is \$200 rather than \$130. The balance of \$70 has been charged to Deposited Account 15-0461. Accordingly, item (1) has been met.

Item (3) and (4) have been met as well.

Item (2) has not been met. It is not clear whether it is being alleged that Mr. Tomoharu Shimada refuses to execute the application or that he cannot be reached after diligent effort. The two are distinct. *See, e.g.*, MPEP 409.03(d), item I. "Inventor Cannot Be Reached" and item II. "Refusal to Join." A first communication was sent to Mr. Shimada at a first address on 06 April 2005. A second communication was sent to Mr. Shimada at a second address on 23 May 2005. It is not clear why the communications were sent to two different addresses less than seven weeks apart. It is not clear whether Mr. Shimada resided at either of these addresses at the time the communications were sent. Accordingly, it is not clear if the inventor is no longer at either of these addresses and his whereabouts are unknown, or if he simply received one or both of the mailings and did not respond. If one or both of the mailings were received and the inventor did not respond, then a refusal to execute the application would likely need to be established. *See* MPEP § 409.03(d), item II. The inventor must be presented with a complete copy of the application papers (specification, including claims, drawing, and oath or declaration) for a refusal to be established. A complete copy of the application papers was sent to the first address but not to the second address in the instant situation. Thus, if Mr. Shimada resides at the second address, a complete copy of the application papers would still need to be presented to him. If it is being alleged that the inventor cannot be reached or found, copies of documentary evidence such as *internet searches*, certified mail return receipts, cover letters of instructions, and telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the affidavit or declaration. *See* MPEP § 409.03, item I.

Translation

Applicants have not yet submitted an accurate translation of the international application as filed. In the translation filed 15 March 2005, a translation of the Figures was not provided. Unless the expression "Fig." is used to identify the drawing(s) in the international application as filed, the expression used to identify the drawing(s) must be translated. See PCT Rule 49.5(f). In the submission filed 15 March 2005, no such translation was provided.

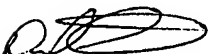
CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

For the above reasons, the decision mailed 03 March 2006 is hereby **VACATED**.

If reconsideration on the merits of this petition is desired, a proper response, including a translation of the Figures, must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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